



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,456	07/02/2003	Yen-Fu Chen	AUS920030421US1	5390
37945 7590 01/26/2011				
DUKE W. YEE				
YEE AND ASSOCIATES, P.C.				
P.O. BOX 802333				
DALLAS, TX 75380				
EXAMINER				
KE, PENG				
ART UNIT		PAPER NUMBER		
2174				
NOTIFICATION DATE		DELIVERY MODE		
01/26/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeciipaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YEN-FU CHEN

Appeal 2009-006521
Application 10/612,456¹
Technology Center 2100

Before JOSEPH L. DIXON, JAY P. LUCAS, and STEPHEN C. SIU,
Administrative Patent Judges.

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL²

¹ Application filed July 2, 2003. The real party in interest is IBM Corp.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellant appeals from a final rejection of claims 1 to 18 and 20 to 22 under authority of 35 U.S.C. § 134(a). Claim 19 is cancelled. (Brief 4, top). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Appellant's invention relates to a method and system for presenting mandatory input fields from a document while not displaying other fields. In the words of Appellant:

A method, apparatus, and computer instructions for presenting input fields from a document. A selected indicator associated with a set of mandatory input fields in the document is identified. The set of mandatory input fields is presented. Further, the mandatory input fields may be pre-filled using data from a repository associated with a user.

(Abstract, Spec. 27).

The following illustrates the claims on appeal:

Claim 1:

1. A method in a data processing system for presenting input fields from a document, the method comprising:

parsing the document to identify a selected indicator associated with a set of mandatory input fields in the document and presenting only the set of mandatory input fields.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Easter	US 2004/0073868 A1	Apr. 15, 2004 (filed on Aug. 27, 2003) ³
Philippe	US 6,882,981 B2	Apr. 19, 2005 (filed on Jun. 23, 2003)

REJECTIONS

The Examiner rejects the claims as follows:

R1: Claims 1 to 4, 7 to 11, 14 to 18, 21 and 22 stand rejected under 35 U.S.C. § 102(e) for being anticipated by Easter.

R2: Claims 5, 6, 12, 13, 20, and 22 stand rejected under 35 U.S.C. § 103(a) for being obvious over Easter in view of Philippe.

ISSUE

The issue is whether Appellant has shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a). The issue specifically turns on whether Easter teaches the parsing step as claimed.

³ Easter claims benefit under 35 U.S.C. § 119(e) of provisional applications Nos. 60/406,046 (08/27/2002) and 60/477,346 (06/11/2003).

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellant has invented of method of helping users identify which fields in a web page form are mandatory and must be filled and which are optional (Spec. 3, l. 18). Only the mandatory input fields are presented to the user (Spec. 5, l. 9).
2. The Easter reference teaches an automated system for generating forms, including some options which can control the visibility of certain fields (Page 10, ¶ [0124]).

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference. In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.

Atlas Powder Co. v. IRECO, Inc., 190 F.3d 1342, 1346 (Fed. Cir. 1999)
(internal citations omitted).

ANALYSIS

*Arguments with respect to the rejection
of claims 1 to 18 and 20 to 22
under 35 U.S.C. § 102(e) and
35 U.S.C. § 103(a) [R1 and R2]*

The Examiner has rejected the noted claims for being anticipated by Easter or being rendered obvious over Easter in view of Philippe. Appellant has raised a number of arguments against these rejections.

Appellant’s first argument concerns the parsing limitation, which reads “parsing the document to identify a selected indicator associated with a set of mandatory input fields.” Appellant contends that Easter, which teaches generating a form into which information will be entered by users, does not actually teach the parsing of a document, by the standard use of the term (Brief 9, bottom). The Examiner points to two relevant sections of Easter: the generation of the form (§ [0124]) and the compliance check of the completed form after being filled by a user (§ [0053]).

We agree with the Appellant that the Easter reference does not teach the parsing of an existing document to present only the mandatory input

fields as claimed (Brief 9, bottom). We cannot read the construction of a form to be filled out later on the parsing of an existing document. The Examiner's reference to a compliance check of a later produced document using the form in ¶ [0053] is noted, but the reference's teaching of parsing is too incomplete and the Examiner's argument too speculative to be the basis for an anticipation rejection. "It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim." *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1457 (Fed. Cir. 1984)).

The Examiner's reference Easter thus fails to support the rejections R1 and R2 respectively under 35 U.S.C. § 102 and 35 U.S.C. § 103.

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude that Appellant has shown that the Examiner erred in rejecting claims 1 to 18 and 20 to 22.

DECISION

We reverse the Examiner's rejections R1 and R2 of claims 1 to 18 and 20 to 22.

REVERSED

Appeal 2009-006521
Application 10/612,456

peb

DUKE W. YEE
YEE AND ASSOCIATES, P.C.
P.O. BOX 802333
DALLAS, TX 75380